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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/330,651	06/11/1999	CONNIE T. MARSHALL	ODS-5	9681

7590

12/10/2003

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EXAMINER
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CHRISTMAN, KATHLEEN M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/330,651

Applicant(s)

MARSHALL ET AL.

Examiner

Kathleen M Christman

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-13, 15-20, 22-28 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 10-13, 15-19, 25-28, and 30-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5, 7-9, 20, and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

In response to the amendment filed 09/23/2003, claims 6 and 21 have been cancelled; claims 1-5, 7-13, 15-20, 22-28, and 30-34 are pending; and claims 1-4, 10-13, 15-19, 25-28 and 30-34 remain withdrawn from consideration. As such claims 5, 7-9, 20 and 22-24 remain under consideration.

### ***Election/Restrictions***

1. This application contains claims 1-4, 10-13, 15-19, 25-28 and 30-34 drawn to an invention nonelected without traverse in Paper No. 18. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 5, 7-9, 20 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Mir et al (US 6450887 B1) and WO/9709699 (hereinafter '699). Regarding claim 5, Mir et al teaches a method which includes displaying a wager input interface for creating a wager on a horse

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race having a plurality of wager requirement and a plurality of selectable options for each of the wager requirements, wherein the wager requirements are displayed so that each wager requirement is substantially aligned in a first dimension, and wherein the plurality of selectable options for each of the plurality of wager requirements is substantially aligned in a second dimension with each corresponding one of the plurality of wager requirements. See Figure 4, where the "\$" symbol and "Pool" represent the wager requirements and "\$1", "\$2", etc. and "Win", "Place", "Show", etc. represent the selectable options associate with the requirements. Mir et al clearly shows that the wager requirements in this format include a wager type selection, and an amount selection. Receiving user inputs and using these inputs to select on of the plurality of selectable options for each of the plurality of wager requirements, as in claim 7, are inherent features.

Mir et al fails to particularly teach that the wager requirements arranged in this manner include a track selection, a race selection, and a horse selection (claim 5); that a selected option is highlighted (claims 8 and 23); and a ticket window that indicates each of the plurality of options selected (claims 9 and 24).

'699 teaches a system and method for interactive wagering that includes the user selection requirements of track selection, race selection, wager type selection, horse selection, and amount selection in figures 35-38, user inputs being used to select at least one of the plurality of options for each of the user selection requirements (claims 7 and 22) also in the above figures, the selected option being highlighted (claims 8 and 23) on page 25 line 21+ and a ticket window that indicates each of the plurality of options selected (claims 9 and 24) in figure 39.

'699 does not teach the specific lay out including all the wagering requirements as claimed by applicant but does show the general "concept" of the layout in Figure 46. Mir et al discloses this layout in Figure 4 as described above.

It is the examiner's position that the incorporation of more wagering requirements into the layout as shown in the Mir et al reference is a matter of design choice. Including more options in one screen would allow for the user to make a faster wager. As such it would be obvious to one of ordinary skill in the art to include track selection, race selection and horse selection (the wager requirements taught by

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the '699 reference) into the single selection display of the Mir et al reference so as to create a faster wagering interface.

Claims 20 and 22 correspond to a system of similar scope to claims 5 and 7, respectively, and are rejected for the same reasons

### ***Response to Arguments***

4. Applicant's arguments filed 09/23/2003 have been fully considered but they are not persuasive. Applicant's arguments are directed to stating that neither the Mir et al nor the '699 reference include a wager input interface where each wager requirement is substantially aligned in a first dimension and each selectable option are substantially aligned in a second dimension with a corresponding one of the plurality of wager requirements where the wager requirements comprise a track selection, a race selection, a wager type, a horse selection, and an amount selection. The examiner agrees that neither reference shows this exact layout. However, it is the examiner's position that given the layout that Mir et al teaches in Figure 4, the addition of wagering requirements such as track selection, race selection and horse selection would be obvious to one of ordinary skill in the art. Especially as these are common and well-known wager requirements, as supported by both the '699 reference and the Mir et al patent itself.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
Kathleen M. Christman

  
Teresa Walberg  
Supervisory Patent Examiner  
Group 3700